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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,958	01/18/2001	Bulent Dervisoglu	260/085 US	9164

23639 7590 04/28/2004  
BINGHAM, MCCUTCHEN LLP  
THREE EMBARCADERO, SUITE 1800  
SAN FRANCISCO, CA 94111-4067

EXAMINER

DOOLEY, MATTHEW C

ART UNIT	PAPER NUMBER
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2133

17

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/765,958

Applicant(s)

DERVISOGLU ET AL.

Examiner

Matthew C. Dooley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 15, 17, 20, 21 and 23 is/are rejected.
- 7) ☒ Claim(s) 16, 18, 19 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 04/09/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,631,504 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 12/03/03, as paper 12, is being considered by the examiner.

### ***Response to Amendment***

3. Applicant's terminal disclaimer and amendment filed 04/09/04, overcome the double patenting rejections and election/restriction requirements put forth in the prior office action, mailed 02/17/04. However, the finality of that action is withdrawn due to new grounds of rejection set forth below.

### ***Allowable Subject Matter***

4. Claims 16, 18-19, and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 16, 18-19, and 22 contain limitations that are not taught by the primary reference used below, Chang '467, in the rejection of claims 1, 15, 17, 20, and 23. Furthermore, Chang can not be demonstrated to be modified with a 103 rejection because the reference qualifies under 102e and as the reference shares a common assignee with the current application, thus any 103 rejection utilizing Chang as a primary reference is disqualified. Furthermore, the remaining prior art of record fails to teach to the limitations cited

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in claims 16, 18-19, and 22. As such, claims 16, 18-19, and 22 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 102***

5. Claims 1, 15, 17, 20, 21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. U.S. 6,269,467.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per claim 1:

Chang teaches to a hierarchical test control network for an IC comprising a top level test control circuit comprising a CAP controller, a plurality of lower level test control circuit blocks connected to a top level control circuit block in a hierarchical structure each comprising a SAP controller, and wherein test operations that are transferred downwards and upwards within the hierarchy (E.g. Fig.61-62; Col.43: 11-16; Col.45: 45-55).

As per claim 15:

The low level blocks of Chang are connected in a serial chain (E.g. Fig.62; Col.45: 17-23, 45-55).

As per claim 17:

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Chang teaches to the use of a test mode input port, a test data input port, and a test data output port (E.g. Col.45: 17-23, 45-55).

As per claim 20:

Chang teaches to a hierarchical test control network for an IC comprising a top level test control circuit comprising a means for controlling a CAP controller, a means for controlling a plurality of lower level test control circuit blocks connected to a top level control circuit block in a hierarchical structure each comprising a SAP controller, and a means for transferring test operations downwards and upwards within the hierarchy (E.g. Fig.61-62; Col.43: 11-16; Col.45: 45-55).

As per claim 21:

The low level blocks of Chang are connected in a serial chain (E.g. Fig.62; Col.45: 17-23, 45-55).

As per claim 23:

Chang teaches to the use of a test mode input port, a test data input port, and a test data output port (E.g. Col.45: 17-23, 45-55).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Dooley whose telephone number is (703) 306-5538. The examiner can normally be reached on M-F 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (703) 305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew Dooley  
Examiner AU 2133  
04/23/04



ALBERT DECADY  
SUPERVISORY PATENT EXAMINER  
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